Supreme Court, U.S.
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No. 99-1614

IN THE

Supreme Court of the United States

INTERNATIONAL SELECT GROUP, INC.,

Petitioner,

v.

FREHLING ENTERPRISES, INC.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE ELEVENTH CIRCUIT

BRIEF IN OPPOSITION

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QUESTIONS PRESENTED

1. A. Whether there is any compelling reason to grant a writ of certiorari under Rule 10 of this Court where, in analyzing the "strength of mark" factor of a likelihood of confusion analysis, the Eleventh Circuit followed the precedent of courts in all Circuits by considering evidence of both marketplace strength and the inherent strength of the OGGETTI mark;

B. Whether there is any compelling reason to grant a writ of certiorari under Rule 10 of this Court where, despite Petitioner's inaccurate characterization of the Eleventh Circuit opinion, the Eleventh Circuit held neither: that the incontestable status of a trademark requires a presumption of strength, nor that the incontestable status of a trademark precludes a defendant from challenging the marketplace strength of a mark.

2. Whether there is any compelling reason to grant a writ of certiorari under Rule 10 of this Court where, in finding clearly erroneous the district court ruling that the trademark OGGETTI for home furniture and furnishings was not infringed by the willful adoption and use of the marks BELL'OGGETTI and 1-800-OGGETTI for home furniture and furnishings, the Eleventh Circuit correctly stated the clearly erroneous standard of review under Fed. R. Civ. P. 52(a) and arrived at the definite and firm conviction that a mistake had been made due to the following:

(i) the undisputed evidence that plaintiff's OGGETTI trademark is inherently strong; incontestably registered; was nationally used and advertised for more than 20 years; and not weakened or diluted by any third-party use of the same or similar mark;

(ii) clear evidence that the OGGETTI and BELL'OGGETTI/1-800-OGGETTI marks are highly similar, and that the "OGGETTI" portion of the infringing marks is the "dominant" portion;

(iii) clear evidence that the parties use their respective OGGETTI and BELL'OGGETTI/1-800-OGGETTI marks for identical goods, namely home furniture and furnishings having similar function and price;

(iv) clear evidence that both parties sell their respective OGGETTI and BELL'OGGETTI home furniture and furnishings in the same channels of trade, namely in furniture stores, in department stores, in mail order catalogs, and to interior designers;

(v) undisputed evidence that the end consumers of both parties' respective OGGETTI and BELL'OGGETTI home furniture and furnishings are identical, namely individuals furnishing their homes;

(vi) undisputed evidence that both parties advertise their respective OGGETTI and BELL'OGGETTI home furniture and furnishings primarily in print, namely magazines, including the same types of magazines aimed at the same demographic of consumer;

(vii) undisputed evidence that the defendant did not conduct an availability search, did not investigate plaintiff's use of the OGGETTI mark upon receiving a refusal to register its BELL'OGGETTI

mark from the U.S. Patent and Trademark Office, knowingly adopted the infringing 1-800-OGGETTI mark, and persisted in its infringement against the advice of its own counsel to stop; and

(viii) undisputed evidence of actual confusion by a particularly relevant individual in the marketplace, namely a professional BELL'OGGETTI buyer.

CORPORATE DISCLOSURE STATEMENT

The Respondent has no parent, and no publicly held company owns 10% or more of its stock.

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STATEMENT OF THE CASE

Respondent Frehling Enterprises, Inc. ("Frehling") brought this case against International Select Group, Inc. ("ISG") for trademark infringement, unfair competition and false designation of origin under 15 U.S.C. §§ 1114 and 1125(a). The case was brought to rectify ISG's intentional infringement of Frehling's federally registered OGGETTI trademark for home furniture and furnishings due to ISG's knowing adoption of the marks BELL'OGGETTI and 1-800-OGGETTI for home furniture and furnishings. The U.S. District Court for the Southern District of Florida ruled that there was no trademark infringement despite the strength of Frehling's mark, the clear similarity of the marks, goods, channels of trade, end consumers, and advertising media of the parties, as well as strong evidence of ISG's intent and actual confusion. The U.S. Court of Appeals for the Eleventh Circuit reversed, finding the District Court ruling to be clearly erroneous.

REASONS FOR DENYING THE WRIT

Rule 10 of this Court states in part that "a writ of certiorari will be granted only for compelling reasons," and "is rarely granted when the asserted error consists of erroneous factual findings or the misapplication of a properly stated rule of law." ISG attempts to create a compelling reason for granting a writ of certiorari by mischaracterizing the Eleventh Circuit precedent and the decision in this case to claim a split of authority amongst the Circuits where there is none. This is a straightforward trademark case where the Eleventh Circuit stated the appropriate standard for review, namely the clearly erroneous standard, and found compelling reasons to reverse the district court. This Court should not

invoke its jurisdiction over this case where no important federal question or conflict exists.

ISG argues two reasons why the writ should be granted as follows:

> (1) because it claims there is a split of authority among the Circuits as to whether the incontestable status of a trademark precludes a defendant from challenging the marketplace strength of a mark under the likelihood of confusion analysis; and
>
> (2) because it claims the Eleventh Circuit exceeded its scope of review under Fed. R. Civ. P. 52(a).

ISG's first assertion is somewhat confused because it poses the issue in two entirely separate manners. That is, in its "Questions Presented" section, ISG states the issue as relating to incontestable status raising a presumption of strength, but ISG ultimately argues essentially that some Circuits, including the Eleventh Circuit, preclude a defendant from presenting evidence of marketplace strength if a mark is incontestable. Regardless, this compound assertion of ISG fails for two reasons. First, the Eleventh Circuit in this case did not hold that the incontestable status of a mark requires a presumption that a mark is strong, nor did it hold that such status precludes evidence as to marketplace strength. In fact, the Eleventh Circuit did exactly the opposite. Consistent with Eleventh Circuit precedent, and that of courts in all other Circuits, the Court considered *both* the inherent strength of the mark *and* evidence as to the marketplace strength of the mark. The second reason this assertion fails is because there

is simply not any split in the Circuits as to whether the incontestable status of a trademark precludes a defendant from challenging the marketplace strength of a mark under the likelihood of confusion analysis. Thus, there is no issue posed, much less an important federal question or conflict, to compel this Court to grant a writ of certiorari.

ISG's second assertion fails for two reasons, as well. First, this case involves a simple application of the clearly erroneous standard as correctly stated by the Eleventh Circuit and nothing more. Second, there was truly overwhelming evidence in the record that the intentional adoption of the marks BELL'OGGETTI and 1-800-OGGETTI for home furniture and furnishings infringed the mark OGGETTI for home furniture and furnishings. The Eleventh Circuit certainly had a definite and firm conviction that the district court made a mistake and was left with no choice but to find the district court's decision to be clearly erroneous. Indeed, had the Eleventh Circuit affirmed the district court's published decision, the integrity of trademark law in that Circuit would have been greatly compromised.

I. A. THE ELEVENTH CIRCUIT ANALYZED BOTH THE INHERENT STRENGTH AND MARKETPLACE STRENGTH PRONGS IN CONSIDERING THE STRENGTH OF MARK FACTOR OF THE LIKELIHOOD OF CONFUSION ANALYSIS AND DID NOT HOLD THAT THE INCONTESTABLE STATUS OF A TRADEMARK REQUIRES A PRESUMPTION OF STRENGTH

ISG couches this issue as whether the Eleventh Circuit erred in holding that the incontestable status of a trademark requires a presumption that a mark is strong, but ISG argues

that there is a split amongst the Circuit as to whether the incontestable status of a trademark precludes a defendant from challenging the marketplace strength of the mark. There is no such split of authority and, at any rate, the issue does not arise based on the Eleventh Circuit opinion, since the Eleventh Circuit did not make either of these holdings.

First, as to a presumption of strength created by the incontestable status of a mark, the Eleventh Circuit made no such holding. The law in the Eleventh Circuit is well established that both the inherent strength and marketplace strength of a mark must be considered. Thus, in *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966 (11th Cir. 1983), the Eleventh Circuit held that both marketplace strength and inherent distinctiveness of the mark are vital considerations. *Id.* at 975; *see also Safeway Stores, Inc. v. Safeway Discount Drugs, Inc.*, 675 F.2d 1160, 1164 (11th Cir. 1982) (both inherent strength and marketplace strength should be considered). Similarly, in this case, the Eleventh Circuit considered the inherent strength, noted the probative nature of the incontestable status of the mark on inherent strength, and also considered marketplace strength, such as the lack of third party usage. Eleventh Circuit Opinion, attached to ISG's petition as Appendix A, at 8a-10a [hereinafter "App. A, at __"]. The Court noted that the lack of third party use (dilution) makes the mark "more easily recognized by consumers." App. A, at 9a. Thus, the Court clearly considered the marketplace strength.

Moreover, as to inherent strength, the Court merely held that "the mark's incontestability serves to enhance its strength." App. A, at 8a. As such, the Eleventh Circuit did not make either of the two holdings that ISG fabricates to formulate an issue for review where one does not exist.

In its brief, ISG sets forth an elaborate discussion of this Court's decision in *Park N' Fly v. Dollar Park & Fly, Inc.*, 469 U.S. 189 (1985). This discussion is irrelevant since, as ISG admits, "this Court did not address the effect of incontestability on the likelihood of confusion analysis in *Park N' Fly*. . . ." ISG's petition at p. 7. ISG further attempts to distort the Eleventh Circuit's holding in *Dieter v. B & H Indus.*, 880 F.2d 322 (11th Cir. 1989), by arguing that the Eleventh Circuit stands alone in holding that if a mark is incontestable, it is presumed to be relatively strong for purposes of infringement. ISG's petition, at p. 8. However, the *Dieter* case does not hold that the incontestable status of a mark creates a presumption of strength in the *marketplace*, nor does it hold that the incontestable status of the mark precludes a Defendant's challenge to marketplace strength of a mark. The *Dieter* Court merely addressed the effect of the incontestable status of a mark in terms of the *inherent* strength of a mark, because the district court below had concluded that the mark at issue was merely descriptive and therefore not entitled to protection. *Id.* at 329. The Court simply stated that the incontestable status of the mark creates a presumption that it is at least descriptive with secondary meaning, and therefore is a relatively strong mark in terms of the inherent strength of the mark. *Id.* The Court in no way indicated that the incontestable status of the mark has any effect on the marketplace strength prong of the "strength of mark" factor. Indeed it does not, and the Eleventh Circuit has consistently analyzed both prongs of this factor, including in the present case.

In short, ISG clearly mischaracterizes the Eleventh Circuit's precedent on this issue and the Eleventh Circuit holding in this case to create an issue where one does not exist.

B. THERE IS NO SPLIT OF AUTHORITY AS TO WHETHER THE INCONTESTABLE STATUS OF A TRADEMARK PRECLUDES A DEFENDANT FROM CHALLENGING THE MARKETPLACE STRENGTH OF A MARK UNDER THE LIKELIHOOD OF CONFUSION ANALYSIS

Not only is the issue not posed by the Eleventh Circuit holding which ISG has mischaracterized, but also contrary to ISG's assertion, there is simply no split amongst the Circuits as to where the incontestable status of a trademark precludes a Defendant from challenging the marketplace strength of a mark under a likelihood of confusion analysis. That is, in considering the "strength of mark" factor in a likelihood of confusion analysis, 12 of the 13 Circuits have considered the issue and held that *both* the inherent strength of a mark *and* the commercial strength of the mark should be weighed, and a district court in the other Circuit, the D.C. Circuit, has held likewise. *The International Association of Machinists and Aerospace Workers v. Winship Green Nursing Center*, 103 F.3d 196 (1st Cir. 1996) (considering registrability and promotion); *Plus Products v. Discount Foods, Inc.*, 722 F.2d 999 (2d Cir. 1983) (two prong test applied); *Fison Horticulture v. Vigoro Indus., Inc.*, 30 F.3d 466 (3d Cir. 1994) (strength measured by spectrum of distinctiveness and commercial recognition); *Petro Stopping Centers, L.P. v. James River Petroleum, Inc.*, 130 F.3d 88 (4th Cir. 1997) (applying two step test); *Sun Banks of Florida, Inc. v. Sun Federal Sav. & Loan Ass'n.*, 651 F.2d. 311 (5th Cir. 1981) (both inherent quality and standing in the marketplace considered); *Homeowners Group, Inc. v. Home Marketing Specialists, Inc.*, 931 F.2d 1100 (6th Cir. 1991) (distinctiveness and recognition considered); *McGraw-Edison Co. v. Walt Disney Prod.*, 787 F.2d 1163 (7th Cir.

1986) (category of mark and use in trade analyzed); *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622 (8th Cir. 1987) (initial step is to categorize mark; overall effect in marketplace important); *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036 (9th Cir. 1999) (two-prong test applied); *King of the Mountain Sports, Inc. v. Chrysler Corp.*, 185 F.3d 1084 (10th Cir. 1999) (conceptual and commercial strength considered); *John H. Harland, supra* (applying two-prong test of strength); *Money Station, Inc. v. Cash Station, Inc.*, 38 U.S.P.Q. 2d 1150 (Fed. Cir. 1995) (considering inherent strength and marketplace strength); *National Information Corp. v. The Kiplinger Washington Editors, Inc.*, 771 F. Supp. 460 (D.D.C. 1991) (analyzing both registration and the tendency of the mark to identify the goods as emanating from a single source).

In short, the Eleventh Circuit considered the inherent strength and marketplace strength of the OGGETTI mark in this case, and ISG's assertion to the contrary is flatly wrong. Moreover, despite ISG's contortions to create one, there is no split of authority amongst the Circuits as to whether the incontestable status of a mark precludes a defendant's challenge of commercial strength. Thus, this compound assertion by ISG raises no compelling reason for this Court to grant a writ of certiorari.

II. THE ELEVENTH CIRCUIT HAD NO CHOICE BUT TO FIND THAT THE DISTRICT COURT DECISION WAS CLEARLY ERRONEOUS, AND SUCH FINDING WAS WELL WITHIN THE SCOPE OF REVIEW UNDER RULE 52(a)

A. The Standard Under Fed. R. Civ. P. 52.

ISG implies that a finding of a district court may only be reversed under the clearly erroneous standard upon a finding of a complete absence of evidence to support the district court's conclusions. Petitioner's Brief, p. 12. However, the standard is not that there is some modicum of evidence that arguably supports the district court's conclusion. Rather, the standard as stated by this Court is that "[a] finding is 'clearly erroneous' when although there is evidence to support it, the reviewing court on the entire evidence is left with a definite and firm conviction that a mistake has been committed." *Anderson v. City of Bessemer*, 470 U.S. 564 (1985), citing *United States v. United States Gypsum Co.*, 333 U.S. 364, 395 (1948). The Eleventh Circuit was completely aware of this standard, stating that "[t]he findings as to each factor, and as to the ultimate conclusion regarding whether or not likelihood of confusion existed, are subject to the clearly erroneous standard of review." App. A, at 6a. Applying this standard, the Eleventh Circuit came to the conclusion that the district court ruling was clearly erroneous.

Rule 10 of this Court states that "[a] petition for a writ of certiorari is rarely granted when the asserted error consists of erroneous factual findings or the misapplication of a properly stated rule of law." As such, ISG's argument on this point as a basis for granting a writ of certiorari fails on its face because there is no compelling reason to do so.

Moreover, an analysis of the entire evidence before the district court on the likelihood of confusion factors, and the Eleventh Circuit's commentary on such factors, clearly indicates that the Eleventh Circuit properly applied the clearly erroneous standard and was left with the definite and firm conviction that a mistake was committed.

B. Factors for Likelihood of Confusion[1]

1. *Strength Of Frehling's OGGETTI Mark*

First, the district court itself found that Frehling's OGGETTI mark is inherently strong. App. B, at 36a. As to the strength of Frehling's mark in the marketplace, there is overwhelming evidence of the strength of Frehling's OGGETTI mark to support a definite and firm conviction that the district court made a mistake.

Specifically, there was undisputed evidence that since 1975, Frehling's OGGETTI mark has been, and is, applied to signs at its place of business, business cards, letterhead, distributorship agreements, catalog and advertising agreements, advertisements, catalogs, price lists, postcards, table top displays, mailing labels, invoices, and, tags and labels posted directly on Frehling's furnishings and furniture. There was no evidence of any third-party use of the term "OGGETTI" in the furniture or furnishing industry which may have diluted Frehling's mark. There was undisputed

1. As ISG has done consistently throughout, it addresses the likelihood of confusion factors out of order, apparently to convey some particular importance of the actual confusion factor. This tactic seems to be a recognition of its weakness on the six other factors. It is also noted that there is substantial evidence of actual confusion in the record. At any rate, these factors are addressed herein in the order in which they are analyzed in the caselaw.

evidence of unsolicited, third-party articles in trade journals and magazines consistently referring to Frehling's furniture as OGGETTI, indicating the association in the marketplace of the term OGGETTI with Frehling's furniture. All of this evidence regarding Frehling's prominent usage of its OGGETTI mark in every way possible to maximize consumer recognition over the course of 25 years, as well as unsolicited trade journal articles by independent third parties and the lack of third-party use, was completely ignored by the district court. Indeed, the Eleventh Circuit had no choice but to find that this factor "clearly favors Frehling" App. A, at 10a.

2. *Similarity Of The OGGETTI And BELL'OGGETTI Marks*

With this factor, as well, the evidence is overwhelming to support a finding of clear error by the district court. Specifically, the parties' respective marks are OGGETTI and BELL'OGGETTI. It was undisputed that Frehling's company is OGGETTI, and that its headquarters bears an OGGETTI sign. The parties' registrations are for OGGETTI and BELL'OGGETTI, respectively. There was undisputed evidence of Frehling's use of its OGGETTI mark on signs, labels, tags, mailing labels, order forms, advertisements, and catalogs; as well as Frehling's use of its OGGETTI mark both by itself and with other marks.

The marks OGGETTI and BELL'OGGETTI are phonetically and visually extremely similar. Indeed, the term "Bell" meaning "beautiful" is a merely laudatory, weak portion of ISG's mark, while the term "Oggetti" is the dominant portion of ISG's mark as shown by its intentional adoption of the toll-free number 1-800-OGGETTI. Further,

both the OGGETTI and BELL'OGGETTI marks are Italian and create an Italian connotation, and there was undisputed evidence that both Frehling and ISG advertise their respective furniture products as having Italian design.

The U.S. Patent and Trademark Office ("PTO") initially refused registration of ISG's application to register the BELL'OGGETTI mark based on a determination of likelihood of confusion between the OGGETTI and BELL'OGGETTI marks, and on September 29, 1996, the PTO found Frehling's OGGETTI mark confusingly similar to ISG's BELL'OGGETTI mark, stating that "the adjective 'bell,' which translates to 'beautiful,' does not alter the mark in a manner which negates similarity." Further, despite the clear analogy to this case, and admitting detailed knowledge of both HENREDON high quality furniture and BELL'OGGETTI furniture, ISG's own expert witness at trial could not bring himself to say that ISG's use of BELL'HENREDON for ISG's "type" of furniture would not be an infringement of HENREDON'S trademark rights.

Frehling's trademark expert, a former Administrative Law Judge with the U.S. Patent and Trademark Office Trademark Trial and Appeal Board (TTAB), and author of the definitive treatise on TTAB practice and procedure, opined that the marks OGGETTI and BELL'OGGETTI are confusingly similar and that this factor strongly favors a finding of trademark infringement.

As such, the Eleventh Circuit noted the striking similarity between the marks, held that "this factor strongly favors Frehling," and noted that the district court "clearly erred in concluding otherwise." App. A, at 10a.

3. *Similarity Of The OGGETTI And BELL'OGGETTI Products*

Again, the evidence overwhelmingly supported the Eleventh Circuit's finding that the district court clearly erred in holding that this factor favored ISG.

It was undisputed that both Frehling and ISG sell furniture and furnishings under their respective OGGETTI and BELL'OGGETTI marks for use in the home, not the office. There was substantial evidence that the majority of Frehling's OGGETTI furniture ranges in price from $495 to $3,000, and the majority of ISG's BELL'OGGETTI furniture ranges from $300 to $2,600. There was undisputed evidence of many overlapping price points for the parties' comparable furniture items, including, for example, Frehling's black metal and glass OGGETTI trolley which lists for $495 and ISG's various BELL'OGGETTI black metal and glass trolleys which list for about $300 to $400.

It was undisputed that both Frehling and ISG market their respective OGGETTI and BELL'OGGETTI home furniture and furnishings as having Italian design. There was also clear evidence that both Frehling and ISG sell furniture capable of holding, or specifically designed to hold, televisions, stereos and other home electronics, and that both Frehling and ISG sell desks for the home office, carts, and wall units under their respective OGGETTI and BELL'OGGETTI marks.

In an attempt to distinguish the parties' respective home furniture and furnishings, ISG argued to the district court that its BELL'OGGETTI furniture is primarily metal and glass while only part of Frehling's OGGETTI furniture is

made from such materials. ISG disingenuously referred to its home furniture as "equipment" in this case, even though ISG consistently advertises its goods as fine home furniture. However, ISG conceded that BELL'OGGETTI metal furniture competes with wood furniture; BELL'OGGETTI furniture is advertised as fine home furniture that will compliment any decor; and BELL'OGGETTI furniture is displayed in advertising with other "types" of furniture and bearing furnishing accessories such as glass vases also sold by Frehling under its OGGETTI mark. Moreover, it was established that both parties' furniture lines have expanded and are continuing to do so.

In short, there is little doubt that the district court clearly erred and that the overwhelming evidence supported the Eleventh Circuit's firm conviction that a mistake had been made on this factor.

4. *Similarity Of The OGGETTI And BELL'OGGETTI Channels Of Trade And Consumers*

The Eleventh Circuit noted that this factor requires a determination as to where, how, and to whom the party's products were sold. App. A, at 14a-15a. There was an enormous amount of evidence of substantial overlap between the parties' channels of trade and customer bases which the district court ignored. This clear evidence was overwhelming and justifies the Eleventh Circuit's finding that the district court's weighing of this factor was clear error. App. A, at 16a.

Specifically, it was undisputed that both Frehling and ISG sell their respective OGGETTI and BELL'OGGETTI home furniture and furnishings on the wholesale level

(*e.g.*, through manufacturers' representatives and to dealers), and that both parties' products are re-sold on the retail level. The evidence also established that both Frehling and ISG sell their respective OGGETTI and BELL'OGGETTI home furniture and furnishings in furniture stores, in department stores, in mail order catalogs, and to interior designers. It was undisputed that ISG sold its BELL'OGGETTI furnishings in the *Costco* catalog, which carries Murano glass furnishings identical to Frehling's OGGETTI Murano glass furnishings, and that the *Costco* catalog has solicited Frehling to list its OGGETTI furnishings from time to time.

It was also established that not only are the parties' price points similar, but the end consumers of both parties' furniture and furnishings are identical, namely individuals furnishing their homes. Indeed, the evidence indicated that both Frehling and ISG advertise in magazines with virtually identical readership demographics — Frehling advertises its OGGETTI home furniture and furnishings in *Interior Design* and *Architectural Digest*, and ISG advertises its BELL'OGGETTI home furniture in *House Beautiful* and *Design Times*. Although ISG argued to the district court that it primarily advertises in consumer electronics magazines, there was undisputed evidence that ISG expended a quarter of its advertising budget on advertising in *House Beautiful* and *Design Times*, targeting its advertising at the readers of those magazines who are also Frehling's potential customers. Indeed, it was established that Frehling was solicited by *Design Times* to advertise its OGGETTI home furniture and furnishings in that magazine in December 1996.

It was further established that the readership demographics of *Design Times* and *House Beautiful*, in which BELL'OGGETTI advertises, also make them appropriate

magazines for advertisements of Frehling's OGGETTI home furniture and furnishings, which are targeted to readers who are likely to purchase Frehling's OGGETTI home furniture and furnishings. In fact, ISG admitted that *Design Times* is aimed at upscale consumers, belying ISG's contention that it does not target those consumers, and ISG admitted its intention to continue advertising its BELL'OGGETTI home furniture in *Design Times* in the future.

It is impossible to imagine how the district court determined that this factor favors ISG in light of the overwhelming evidence to the contrary. The Eleventh Circuit was more than justified in finding the district court's determination on this factor to be clearly erroneous.

5. *Similarity Of The OGGETTI And BELL'OGGETTI Advertising*

On this factor, the Eleventh Circuit noted the *correct* standard, namely that this factor looks to each party's method of advertising, not whether the publications or advertising media used by the parties are identical. The evidence overwhelmingly led the Eleventh Circuit to find that both parties "advertise in periodicals, and very similar ones at that." App. A, at 17a.

Specifically, there was undisputed evidence that both Frehling and ISG advertise their respective OGGETTI and BELL'OGGETTI home furniture and furnishings primarily in print media, namely magazines, with a large percentage of both parties' advertising being aimed at the consuming public, interior designers, and decorators. As stated previously, Frehling has advertised its OGGETTI home furniture and furnishings in magazines such as *Interior*

Design and *Architectural Digest*, and ISG has advertised its BELL'OGGETTI home furniture in similar magazines such as *Design Times* and *House Beautiful*. It was established that both Frehling and ISG advertise their respective OGGETTI and BELL'OGGETTI home furniture and furnishings in catalogs, such as *Costco*, a catalog in which ISG advertises its BELL'OGGETTI home furnishings and which has solicited Frehling to carry its OGGETTI home furnishings.

Moreover, it was established that ISG expended a large percentage of its advertising resources in running full-page advertisements of its BELL'OGGETTI home furniture in *Design Times* and *House Beautiful* magazines, both of which have solicited Frehling to advertise its OGGETTI furniture and furnishings.

In short, there was clear evidence that overwhelmingly favored a weighing of this factor in favor of Frehling, but the district court failed to do so. The Eleventh Circuit's determination that a clear error was made by the district court was appropriate.

6. *ISG's Intent In Selecting The BELL'OGGETTI Mark*

On this factor, ISG argued that the district court "concluded that this factor favored Frehling slightly. . . ." ISG's Petition, p. 20, citing App. B, at 39a. This is a blatant mischaracterization. The district court did not find this factor only favored Frehling "slightly." Rather, the district court found that ISG was intentionally blind, noted that ISG "adopted the 1-800-OGGETTI toll-free number with full knowledge of [Frehling's] prior ownership rights to the OGGETTI mark," and found "this factor weighs in favor of [Frehling]." App. B, at 39a.

Despite the district court finding that this factor favored Frehling, the Eleventh Circuit appeared to be troubled again by the district court's failure to consider the additional, overwhelming evidence of intent. Specifically, the Eleventh Circuit noted that ISG's intentional blindness was manifested by its failure to conduct a trademark search before attempting to register the BELL'OGGETTI mark in 1990. App. A, at 18a. The Court also noted that after ISG's request to register the BELL'OGGETTI mark was refused by the PTO due to likelihood of confusion with Frehling's OGGETTI mark, ISG continued to pursue registration without any attempt to contact Frehling or investigate likelihood of confusion. *Id.* The Eleventh Circuit noted that "ISG clearly had notice as to the strong similarity of the marks and hence was aware that they may be confused and yet continued to use the 'BELL'OGGETTI' mark." *Id.* Thereafter, ISG adopted the 1-800-OGGETTI toll-free number with complete knowledge of Frehling's prior rights, and the Eleventh Circuit noted this "direct replication of Frehling's OGGETTI mark." *Id.* The Eleventh Circuit also noted that "ISG continued to use the 1-800 number despite Frehling's repeated objections and contrary to the advice of its own counsel." *Id.*

In short, the Eleventh Circuit found that ISG's improper intent was prevalent, and the evidence overwhelmingly supported the Eleventh Circuit holding that "this factor weighs substantially in Frehling's favor." *Id.*

7. *Actual Confusion Between OGGETTI And BELL'OGGETTI Home Furniture And Furnishings*

The district court did not appear to make any determination as to whether this factor weighs in favor of one party or the other. The district court simply stated that

the incident of actual confusion by one of ISG's own customers proven at trial was "not sufficient to show actual confusion." App. B, at 40a.

In reviewing the district court's finding on this factor, the Eleventh Circuit expressed concern over the district court's failure to evaluate the specific type of person actually confused, namely an ISG customer, as being particularly relevant. The Eleventh Circuit also appeared to be troubled by the fact that the district court did not find the testimony regarding the instance of actual confusion to lack credibility but simply decided not to give it much weight. The Eleventh Circuit limited its review of this factor to find that there was at least one instance of actual confusion but concluded that "this factor is not sufficiently dispositive to favor either side in an appreciable fashion." App. A, at 21a.[2]

In short, the Eleventh Circuit held "that Frehling demonstrated a likelihood that its senior 'OGGETTI' mark would be confused with ISG's junior 'BELL'OGGETTI' mark", and that "the district court's conclusion to the contrary, that there was no likelihood of confusion, was clearly erroneous." App. A, at 21a. In addition to common sense that the senior use of OGGETTI for home furniture and furnishings is infringed by an intentional junior use of BELL'OGGETTI and 1-800-OGGETTI for home furniture and furnishings, there was overwhelming evidence on each

2. It is also noted that in analyzing the instance of actual confusion by ISG's customer proven at trial, the district court failed to consider the context of the parties' growth, overlap, and opportunity for actual confusion to arise and be discovered. The district court also did not note the difficulty in uncovering actual confusion, nor that this instance of actual confusion was particularly relevant because it involved ISG's own customer.

and every factor favoring a likelihood of confusion determination. The district court ignored compelling evidence in its finding of no infringement. The Eleventh Circuit expressed extreme concern with the district court's conclusions and was clearly left with the definite and firm conviction that the district court had erred. As such, there was no abuse of discretion.

CONCLUSION

For the foregoing reasons, this Court should deny writ of certiorari.

Respectfully submitted,

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